

**REMARKS**

I. Claim Rejections Under 35 U.S.C. § 102(e)

Claims 1, 4, 5, 6, 8, 14, 15, 16, 17, 19 and 20 were rejected under 35 U.S.C. 102(e) as being anticipated by Hsu (U.S. Pat. No. 6,332,727). It is respectfully submitted that claims 1, 4, 5, 6, 14, 15, 16, 17, 19, and 20 are not anticipated.

A. Independent Claim 1 Is Not Anticipated by Hsu

Claim 1 is directed to a sales promotional writing apparatus. The apparatus comprises in part an attachment member, wherein the attachment member includes a cavity exposed in an attachment surface, “the cavity including at least one locking member.” It further comprises in part an “insertion member having an insertion profile adapted for insertion into the cavity, the insertion member further comprising at least one receiving member adapted to receive the at least one locking member.”

Hsu discloses a ballpoint pen stand decorated with a twist dancing ornament. See Hsu, Fig. 2. Hsu does not disclose an insertion member containing at least one receiving member adapted to receive the at least one locking member. Hsu discloses a wire fastener 4 comprising two half torsos 41 and 42 which are firmly held together by at least two lock bolts 43 on one half torso and at least two lock cavities 44 on the other half torso. See Hsu, Fig. 1; col. 2, ll. 19-25. This locking mechanism merely holds the two half torsos in place. Although the wire fastener houses the metal wire 3, Hsu does not disclose that the metal wire includes an insertion member adapted to receive the at least one locking member of the half torsos. On the contrary, the metal wire at the L-shape bent point 31 is free to spin around inside the wire fastener. See Hsu, Figs. 4 and 5. Hsu further discloses that it is “unnecessary for the metal wire to pass the aperture or the L-shape channel” and that “it permits to directly clamp or attach to the ornament seat.” See Hsu, col. 2, l.66; col. 3, ll. 1-2. Hsu fails to teach or suggest an insertion member comprising at least one receiving member adapted to receive the at least one locking member of the cavity included in the attachment member.

Hsu, therefore, fails to disclose an attachment member, wherein the attachment member includes a cavity exposed in an attachment surface, “the cavity including at least one locking member” and a display member including an “insertion member having an insertion profile adapted for insertion into the cavity, the insertion member further comprising at least one receiving member adapted to receive the at least one locking member.” Reconsideration and withdrawal of the rejection of claim 1 is respectfully requested. Accordingly, claim 1 is in condition for allowance.

B. Claims Depending From Claim 1 Are Patentable

Because claims 4, 5, 6 and 8 depend directly or indirectly from claim 1 and incorporate all the limitations of claim 1, the above argument obviates the basis for this ground of rejection. Thus, claims 4, 5, 6 and 8 are not anticipated by Hsu. Reconsideration and withdrawal of the rejection is respectfully requested.

C. Independent Claim 14 is Not Anticipated by Hsu

Claim 14 is directed to a sales promotional writing apparatus. The apparatus comprises in part an attachment member, wherein the attachment member includes a cavity exposed in an attachment surface, “the cavity including at least one locking member.” It further comprises in part an “insertion member having an insertion profile adapted for insertion into the cavity, the insertion member further comprising at least one receiving member adapted to receive the at least one locking member.”

Hsu discloses a ballpoint pen stand decorated with a twist dancing ornament. See Hsu, Fig. 2. Hsu does not disclose an insertion member containing at least one receiving member adapted to receive the at least one locking member. Hsu discloses a wire fastener 4 comprising two half torsos 41 and 42 which are firmly held together by at least two lock bolts 43 on one half torso and at least two lock cavities 44 on the other half torso. See Hsu, Fig. 1; col. 2, ll. 19-25. This locking mechanism merely holds the two half torsos in place. Although the wire fastener houses the metal wire 3, Hsu does not disclose that the metal wire includes an insertion member adapted to receive the at least one locking member of the half torsos. On the contrary,

the metal wire at the L-shape bent point 31 is free to spin around inside the wire fastener. See Hsu, Figs. 4 and 5. Hsu further discloses that it is “unnecessary for the metal wire to pass the aperture or the L-shape channel” and that “it permits to directly clamp or attach to the ornament seat.” See Hsu, col. 2, l.66; col. 3, ll. 1-2. Hsu fails to teach or suggest an insertion member comprising at least one receiving member adapted to receive the at least one locking member of the cavity included in the attachment member.

Hsu, therefore, fails to disclose an attachment member, wherein the attachment member includes a cavity exposed in an attachment surface, “the cavity including at least one locking member” and a display member including an “insertion member having an insertion profile adapted for insertion into the cavity, the insertion member further comprising at least one receiving member adapted to receive the at least one locking member.” Reconsideration and withdrawal of the rejection of claim 14 is respectfully requested. Accordingly, claim 14 is in condition for allowance.

D. Claims Depending From Claim 14 Are Patentable

Because claims 15, 16, 17, 19 and 20 depend directly or indirectly from claim 14 and incorporate all the limitations of claim 14, the above argument obviates the basis for this ground of rejection. Thus, claims 15, 16, 17, 19 and 20 are not anticipated by Hsu. Reconsideration and withdrawal of the rejection is respectfully requested.

II. Claim Rejections Under 35 U.S.C. § 103(a)

Claims 2, 3, 9, 10 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hsu (U.S. Pat. No. 6,332,727) in view of Ho (U.S. Pat. No. 5,947,322). It is respectfully submitted that claims 2, 3, 9, 10 and 12 are not unpatentable.

In considering obviousness, references may not be combined unless there is a reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to make the combination, and that would also suggest a reasonable likelihood of success. *Smiths Indus. Med. Sys. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356 (Fed. Cir. 1999). The mere possibility

that the references could be combined is insufficient to support the conclusion of obviousness. Gen Gallery, Inc. v. Berkline Corp., 134 F.3d 1473, 1478 (Fed. Cir. 1998). Consequently, there is no legal basis for concluding that an invention would have been obvious “solely because it is a combination of elements that were known in the art at the time of the invention.” Smith Indus. Med. Sys., 183 F.3d at 1356. Even if the references could be properly combined, the prior art combination does not teach suggest all of the elements in claims 2, 3, 9, 10 and 12 of the present invention.

A. Independent Claim 1 Is Not Made Obvious By Hsu In View Of Miller

As discussed above, claim 1 comprises in part an attachment member, wherein the attachment member includes a cavity exposed in an attachment surface, “the cavity including at least one locking member” and a display member including an “insertion member having an insertion profile adapted for insertion into the cavity, the insertion member further comprising at least one receiving member adapted to receive the at least one locking member.”

Hsu, as presented above, teaches a ballpoint pen stand decorated with a twist dancing ornament, wherein the metal wire does not include an insertion member adapted to receive the at least one locking member of the wire fastener. Hsu fails to teach or suggest an insertion member comprising at least one receiving member adapted to receive the at least one locking member of the cavity included in the attachment member.

Ho fails to remedy this deficiency of Hsu. Ho is relied upon as teaching the convenient storage of the device described in Hsu when the device is not in use. See Office Action, p.5, ll. 3-6. Ho fails to teach or suggest an insertion member comprising at least one receiving member adapted to receive the at least one locking member of the cavity included in the attachment member.

Neither Hsu nor Ho, alone or in combination, teach or suggest an insertion member comprising at least one receiving member adapted to receive the at least one locking member of the cavity included in the attachment member. Accordingly, claim 1 stands in condition for allowance.

B. Claims Depending From Claim 1 Are Patentable

Because claims 2 and 3 depend directly or indirectly from claim 1 and incorporate all the limitations of claim 1, the above argument obviates the basis for this ground of rejection. Thus, claims 2 and 3 are not made obvious over Hsu in view of Ho. Reconsideration and withdrawal of the rejection is respectfully requested.

C. Independent Claim 9 Is Not Made Obvious By Hsu In View Of Miller

Claim 9 is directed to a method for presenting sales promotional marketing materials to a consumer at a point of sale. 35 U.S.C. §§ 100(b) and 101 expressly authorize a patent on a method which is a new use of a known machine, provided the method “predicated on the new use is new and unobvious.” In re Zierden, 411 F.2d 1325, 1329 (C.C.P.A. 1969). It is respectfully submitted that the method of claim 9 is not unpatentable over Hsu in view of Ho.

Hsu discloses a ballpoint pen stand decorated with a twist dancing ornament. See Hsu, Fig. 2. However, Hsu does not disclose any use of the ornament as sales promotional marketing materials. On the contrary, Hsu refers to the ornament as a “twist dancing ornament,” or more generally, as a “toy.” See Hsu, col. 1, ll. 24-25; col. 3, l. 23. Furthermore, none of the examples of alternate ornaments presented in Hsu teach or suggest the use of sales promotional marketing materials. See Hsu, col. 2, ll. 62-63.

Ho fails to remedy this deficiency of Hsu. Ho is relied upon as teaching the convenient storage of the device described in Hsu when the device is not in use. See Office Action, p.5, ll. 3-6. Ho fails to teach or suggest a method for presenting sales promotional marketing materials to a consumer at a point of sale.

Neither Hsu nor Ho, alone or in combination, teach or suggest a method for presenting sales promotional marketing materials to a consumer at a point of sale. Accordingly, claim 9 stands in condition for allowance.

D. Claims Depending From Claim 9 Are Patentable

Because claims 10 and 12 depend directly or indirectly from claim 9 and incorporate all the limitations of claim 9, the above argument obviates the basis for this ground of rejection. Thus, claims 10 and 12 are not made obvious over Hsu in view of Ho. Reconsideration and withdrawal of the rejection is respectfully requested.

III. Newly Presented Claim 21

New claim 21 includes a sales promotional writing apparatus comprising a writing member comprising a body defining a longitudinal axis and a attachment member in a substantially transverse orientation to the longitudinal axis, the body including a lumen adapted to fixedly receive a writing insert, the attachment member including a cavity exposed in an attachment surface, the cavity including at least one locking member; and a display member comprising at least one display surface and an insertion member attached to the display member, the insertion member having an insertion profile adapted for insertion into the cavity, the insertion member further comprising at least one receiving member adapted to receive the at least one locking member. These aspects of the invention are not disclosed by the prior art of record. Accordingly, claim 21 is in condition for allowance.

IV. Allowable Subject Matter

Claims 7, 11, 13 and 18 were objected to as being dependent upon a rejected base claim, but were indicated allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. For the reasons set forth above, claims 7, 11, 13 and 18 are no longer believed to be dependent upon a rejected base claim.

CONCLUSION

Claims 1-21 are pending. Claim 21 has been added. In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Kyle T. Peterson", with a stylized flourish at the end.

Kyle T. Peterson  
Registration No. 46,989

Customer No. 24113  
Patterson, Thunte, Skaar & Christensen, P.A.  
4800 IDS Center  
80 South 8th Street  
Minneapolis, Minnesota 55402-2100  
Telephone: (612) 252-1554

AMENDMENTS TO THE DRAWINGS

The drawings were objected to because reference character 152 was not present in any of the drawings. FIG. 5 has been amended to include reference character 152. A corrected drawing showing changes made is attached.